

REMARKS

Status of the Application

Claims 1-46 were pending in the application. Claims 1, 2, 24, and 25 were rejected. No claims were allowed. Claims 3-23, and 26-46 were objected to.

By this amendment, claims 1 and 24 have been revised and claims 2 and 25 have been canceled. Therefore, claims 1, 3-24, and 26-46 are now pending and before the examiner for consideration.

Objections to the Specification

In the Office Action the disclosure was objected to for the following informalities: U.S. application 09/679,710 has issued as U.S. patent 6,576,232; not all of the panels are described in the brief description of Figures 3 and 5; and there are sequences on pages 40 and 41 that lack sequence identifiers. The specification has been amended to correct these errors and replacement sheets are attached hereto. The first paragraph of the specification has been amended to include U.S. patent number 6,576,232. The objection to the brief description of Figure 3 is improper because Figure 3 contains three panels (A, B, and C), and the brief description of Figure 3 in the specification as filed describes panels A, B, and C. The brief description of Figure 5 on pages 10 and 11 has been amended to replace "panel A" and "panel B" with "column A" and "column B", respectively. This change accurately reflects the two columns that are present in Figure 5, each containing several panels. The panels of Figure 5 are further described elsewhere in the specification (see pages 51-52). The specification has been amended to include sequence identifiers following the sequences on pages 40 and 41. Withdrawal of these objections is respectfully requested.

Rejection Under 35 U.S.C. 102(b)

Claims 1, 2, 24 and 25 were rejected under 35 U.S.C. 102(b) as being anticipated by Debinski, et al., Nature Biotechnology, volume 16, pages 449-453. In particular, the Office Action stated:

Debinski, et al. teaches the mutant E13K, which is instant SEQ ID NO: 2 (p. 449). While Debinski, et al. does not teach the encoding sequences, a person of ordinary skill would envisage the claimed polynucleotides from the disclosed sequences. The polynucleotides, were, therefore, in the public domain. If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. In re Petering, 133 USPQ 275 (CCPA 1962).

In view of the Examiner's statements, claim 1 (from which claims 2 and 24 depend) and claim 24 (from which claim 25 depends) have been amended to recite "SEQ ID NOs: 3-23" instead of "SEQ ID NOs: 2-23." Claims 2 and 25 have been cancelled. Applicants do not necessarily agree with or acquiesce in this rejection, but have made these amendments solely to expedite prosecution of this application to completion. Withdrawal of this rejection is respectfully requested.

Claim Objections

In the Office Action claims 3-23 and 26-46 were objected to as being dependent upon a rejected independent base claim. The Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim. As claims 3-23 and 26-46 depend upon amended claim 1, an independent base claim believed allowable, withdrawal of this objection is therefore respectfully requested.

Conclusion

The currently pending claims before the examiner are supported throughout the specification and are patentable over the prior art. No new matter has been added. This application is now in full condition for allowance, and such action is respectfully requested.


The Commissioner is hereby authorized to charge any underpayment or credit any overpayment of fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account 50-0951.

The examiner is cordially invited to call the undersigned if clarification is needed on any matter within this amendment, or if the examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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